This application has been reviewed in light of the Office Action dated May 23, 2007. Claims 1-23 are presented for examination, of which Claims 1, 12, and 23 are in independent form. Claims 1, 12, and 23 have been amended to define more clearly what Applicant regards as his invention. Favorable reconsideration is requested.

Claim 23 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant has carefully reviewed and amended Claim 23, as deemed necessary, to ensure that it conforms fully to the requirements of 35 U.S.C. § 101, with special attention to the points raised in section 3 of the Office Action. It is believed that the rejection under 35 U.S.C. § 101 has been obviated, and its withdrawal is therefore respectfully requested.

Claims 1, 2, 4-6, 9-13, 15-17, and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,089,286 (*Malik*) and U.S. Patent 6,825,955 (*Shibata*); Claims 3, 8, 14, and 19 were rejected as being unpatentable over *Malik* and *Shibata* in view of U.S. Patent 6,868,183 (*Kodaira*); and Claims 7 and 18 were rejected as being unpatentable over *Malik* and *Shibata* in view of U.S. Patent 6,157,389 (*Knowlton*). Applicant submits that independent Claims 1, 12, and 23, together with the claims dependent therefrom, are patentably distinct from the cited prior art for at least the following reasons.

One aspect of the present invention, set forth in Claim 1, is a communication apparatus comprising connecting means for connecting the communication apparatus to a communication network containing an electronic mail exchange device. Input means are provided for inputting image data representing an image, and transmitting means transmit an

electronic mail, to which the image data inputted by the input means is attached, via the connecting means. Receiving means are provided for receiving an electronic mail as notification of an error, via the connecting means, and analyzing means analyze such electronic mail. Converting means are provided for converting the size of the image data into a smaller size according to an analysis result obtained by the analyzing means, and control means in such a case automatically carry out a controlling operation to retransmit the electronic mail, with the reduced-size image data attached, by the transmitting means, in response to the receiving means receiving such electronic mail notifying that the size of the earlier electronic mail transmitted by the transmitting means is too large. Also provided are output means that output a report including at least a transmitting date, a destination and information for specifying a conversion method, for converting the size of the input image data into the smaller size, used by the converting means, in a case where the retransmitting of the electronic mail by the transmitting means has been carried out.

Among other notable features of Claim 1 are the output means for outputting a report including at least a transmitting date, a destination and information for specifying a conversion method, for converting the size of the input image data into the smaller size, used by said converting means, in a case where the electronic mail has been retransmitted by the transmitting means. This feature makes it possible for a user to recognize, among other things, the method used to convert the input image data when the electronic mail has been retransmitted. An example of this feature is when the printer 2095 prints out the transmission report, as shown in FIGS. 36 and 37. [1]

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[1]   It is of course to be understood that the claim scope is not limited by the details of this or any other particular embodiment that may be referred to.

Malik relates to a system for compressing e-mail attachments for transmission, in which a table stores a compressibility factor for each of various types of files, indicating by what percentage a file of a given type can be compressed. Each attachment of a type whose stored compressibility factor is above a certain value, is compressed. Alternatively, an attachment-configuration module compresses a number of attachment files according to the size of each and the corresponding compressibility factor, in such manner as to maximize the total size of the e-mail communication (after compression) while keeping that total size below a threshold value.

The Office Action concedes that *Malik* does not disclose expressly outputting a report after transmitting an electronic mail. Applicant submits that the deficiencies of *Malik* with respect to the rejection of Claim 1 are not cured by the teachings of *Shibata*.

Shibata, as understood by Applicant, relates to a device, such as a facsimile machine, that is capable of transmitting an image by both electronic mail and facsimile and is also capable of notifying the receiver facsimile device of an incoming electronic mail using a facsimile protocol. At most, *Shibata* discusses a report that may include a transmission mode as to whether the transmission was made in an E-mail mode or a facsimile mode. (*Shibata*, column 12, lines 42-47.) However, Applicant submits that this feature of *Shibata* appears to have nothing to do with information for specifying a conversion method for converting the size of the input image data into a smaller size used by the converting means. Furthermore, *Shibata* mentions nothing about outputting such a report in a case where a retransmitting of the electronic mail by said transmitting means has been carried out, as set forth in Claim 1.

Applicant submits that *Shibata* fails to teach or suggest a communication apparatus that includes output means for outputting a report for specifying a conversion method, for converting the size of the input image data into the smaller size, used by the converting

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means in a case where a retransmitting of the electronic mail by said transmitting means has been carried out.

Accordingly, Applicant submits that Claim 1 is patentable over *Malik* and *Shibata*, considered individually or in any permissible combination (if there is any). Therefore, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a).

Independent Claims 12 and 23 are method and computer medium claims, respectively, corresponding to apparatus Claim 1, and are believed to be patentable for at least the same reasons as discussed above in connection with Claim 1.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or the other of Claims 1 and 12, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place the present application in condition for allowance. Therefore, entry of this Amendment under 37 C.F.R. § 1.116 is believed proper and is respectfully requested, as an earnest effort to advance prosecution and reduce the number of issues. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicant respectfully requests

favorable reconsideration and an early issuance of a Notice of Allowance.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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